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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/079,422	02/22/2002	Masahiro Ichihara	R2184.0135/P135	7009
24998	7590	03/24/2005	EXAMINER	
DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP			LEROUX, ETIENNE PIERRE	
2101 L Street, NW			ART UNIT	
Washington, DC 20037			PAPER NUMBER	
			2161	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/079,422

Applicant(s)

ICHIHARA, MASAHIRO

Examiner

Etienne P LeRoux

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/22/2002.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Claim Status

Claims 1-8 are pending. Claims 1-8 are rejected as detailed below.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 3-5 drawn to method are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts:
- (2) whether the invention produces a useful, concrete and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts to promote the “progress of science and the useful arts” (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use or advance the technological arts.

Claims 3-5 are drawn to a method for managing a plurality of documents. The claims are drawn solely to method steps for linking a section of a first document to a section of a second document based on an pre-existing association. During examination, the claims must be

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interpreted as broadly as their terms reasonably allow and thus examiner maintains a document association object can be interpreted as a mental process performed by a person thinking about an association between a first document and a second document. Such a mental process is an abstract idea and is not patentable. Furthermore, the linking based on the pre-existing association can be done with pencil and paper. Technology is not required for the claimed invention because linking a first document to a second document can be done manually by developing a topic heading and then listing a section reference from a first document and then listing a corresponding section reference from a second document. The claimed method steps do not define structural and functional interrelationships between elements of a computer which is required to realize the functionality of the method steps and thus cause the claimed invention to be statutory.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete and tangible result. In the present case, the invention is useful because linking a section of a document to a section of an other document is useful because it facilitates rapid retrieval of related information of interest to a user.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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Claims 1 and 6 are rejected under 35 U.S.C. 102(e) as being anticipated by US Pat No 6,769,096 issued to Kuppusamy et al (hereafter Kuppusamy).

Claims 1 and 6:

Kuppusamy discloses:

a document association object [Fig 3, 215, col 6, line 60 – col 7, line 5] linking a reference-source document [TOC document 220, Fig 4] to a referenced-material document [target document 202, Fig 4] in the database

a management unit generating property data of the document association object, the property data including a first identifier¹[executive summary 260, Fig 4, col 8, lines 41-50] indicating a section of the reference-source document and a second identifier [bookmark, col 8, line 65 – col 9, line 5, executive summary 264, Fig 4] indicating a section of the referenced-material document, wherein the property data of the document association object is provided to recognize a particular relation [quarterly report, Fig 4, col 7, lines 38-50] that links the reference-source document section to the referenced-material document section

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

¹ Examiner interprets identifier per Webster's New World College Dictionary , Fourth Edition as distinguish or characterize

Claims 2-4, 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuppusamy in view of US Pat No 6,549,916 issued to Sedlar (hereafter Sedlar).

Claim 2:

Kuppusamy discloses the elements of claim 1 as noted above and furthermore also discloses wherein the management unit is configured to generate the property data of the document association object, the property data including the first identifier [TOC document 220, Fig 4], the second identifier [target document 202, Fig 4]. However, Kuppusamy does not disclose a third identifier indicating a version of the reference-source document and a fourth identifier indicating a version of the referenced-material document. Sedlar discloses an identifier indicating a version of the reference-source document and an identifier indicating a version of the referenced-material document [col 35, lines 17-25]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kuppusamy to include a third identifier indicating a version of the reference-source document and a fourth identifier indicating a version of the referenced-material document which includes the teachings of Sedlar for the purpose of maintaining a record of the revisions to the source file and to the target file. The skilled artisan would have been motivated to modify Kuppusamy per the above such that it can be decided whether the link should be traversed or whether a new search should be performed [col 35, lines 3-8].

Furthermore, Sedlar discloses wherein the property data of the document association object is provided to recognize a particular relation that links the reference-source document version and section to the referenced-material document version and section [col 35, lines 1-8]

Claim 3:

Kuppusamy discloses:

providing a document association object linking a reference-source document [TOC document 220, Fig 4] to a referenced-material document [target document 202, Fig 4] in the database

generating property data of the document association object, the property data including a first identifier [executive summary 260, Fig 4, col 8, lines 41-50] indicating a section of the reference-source document, a second identifier [bookmark, col 8, line 65 – col 9, line 5, executive summary 264, Fig 4] indicating a section of the referenced-material document

Kuppusamy discloses the essential elements of the invention as noted above but does not disclose a third identifier indicating a version of the reference-source document and a fourth identifier indicating a version of the referenced-material document. Sedlar discloses an identifier indicating a version of the reference-source document and an identifier indicating a version of the referenced-material document [col 35, lines 17-25]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kuppusamy to include a third identifier indicating a version of the reference-source document and a fourth identifier indicating a version of the referenced-material document which includes the teachings of Sedlar for the purpose of maintaining a record of the revisions to the source file and to the target file. The skilled artisan would have been motivated to modify Kuppusamy per the above such that it can be decided whether the link should be traversed or whether a new search should be performed [col 35, lines 3-8].

Furthermore, Sedlar discloses wherein the property data of the document association object is provided to recognize a particular relation that links the reference-source document version and section to the referenced-material document version and section [col 35, lines 1-8]

Claim 4:

The combination of Kuppusamy and Sedlar discloses the elements of claim 3 as noted above and furthermore Sedlar discloses detecting that a relevant document linked to the document association object is renewed to change a previous version of the relevant document to a new version; and updating the property data of the document association object so that one of the reference-source document version and the referenced-material document version is renewed so as to match the new version of the relevant document [col 30, lines 30-58].

Claim 7:

Kuppusamy discloses the elements of claim 6 as noted above and furthermore also discloses wherein the management unit is configured to generate the property data of the document association object, the property data including the first identifier [TOC document 220, Fig 4], the second identifier [target document 202, Fig 4]. However, Kuppusamy does not disclose a third identifier indicating a version of the reference-source document and a fourth identifier indicating a version of the referenced-material document. Sedlar discloses an identifier indicating a version of the reference-source document and an identifier indicating a version of the referenced-material document [col 35, lines 17-25]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kuppusamy to include a third identifier indicating a version of the reference-source document and a fourth

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identifier indicating a version of the referenced-material document which includes the teachings of Sedlar for the purpose of maintaining a record of the revisions to the source file and to the target file. The skilled artisan would have been motivated to modify Kuppusamy per the above such that it can be decided whether the link should be traversed or whether a new search should be performed [col 35, lines 3-8].

Furthermore, Sedlar discloses wherein the property data of the document association object is provided to recognize a particular relation that links the reference-source document version and section to the referenced-material document version and section [col 35, lines 1-8]

Claim 8:

The combination of Kuppusamy and Sedlar discloses the elements of claims 6 and 7 as noted above and furthermore, Kuppusamy discloses when a relevant document, linked to the document association object, is renewed to change a previous version of the relevant document to a new version, the property data of the document association object so that one of the reference-source document version and the referenced-material document version is renewed so as to match the new version of the relevant document [col 2, lines 30-40, col 7, lines 15-50].

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Kuppusamy and Sedlar and further in view of Pub No US 2003/0046315 (hereafter Feig)

Claim 5:

The combination of Kuppusamy and Sedlar discloses the elements of claim 3 as noted above but does not disclose detecting that a section of a relevant document linked to the document association object is deleted and deleting the document association object including

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the property data. Feig discloses detecting that a section of a relevant document linked to the document association object is deleted and deleting the document association object including the property data [paragraph 72]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the above combination of references to include detecting that a section of a relevant document linked to the document association object is deleted and deleting the document association object including the property data as taught by Feig for the purpose of removing an association of a source document with a target document. The skilled artisan would have been motivated to modify the above combination of references such that a user is able to delete obsolete references between documents.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne LeRoux whose telephone number is (571) 272-4022. The examiner can normally be reached on Monday – Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (571) 272-4023.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Patent related correspondence can be forwarded via the following FAX number (703) 872-9306

Etienne LeRoux

3/19/2005

